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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,144	01/25/2001	Spencer A. Rathus	660-018	8423

7590 12/04/2002  
Ward & Olivo  
382 Springfield Avenue  
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EXAMINER

LE, THIEN MINH

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/769,144

Applicant(s)

RATHUS ET AL.

Examiner

Thien M. Le

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 168-267 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 168-267 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The amendment filed on 9/9/2002 has been entered. Claims 168-267 remain for examination.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 168, 262, and 265 are rejected under 35 U.S.C. 102(b) as being anticipated by Mondshein (Mondshein – 4,418,278; newly cited).

Mondshein discloses a page fabricated with embedded optical fibers is used as an input/output device to facilitate man-machine communication. Pinhole-size perforations in the surface of the page serving as entry/exit ports are located above ends of the embedded optical fibers, thereby to expose the ends of the fibers to the top surface of the page, with the fibers being routed beneath the surface of the page to exit points at the edge of the page. As an input device, information is entered by marking the page with a pencil such that pencil lead is deposited in a selected perforation to prevent light from passing through the perforation in the page and into the underlying optical fiber, the state of the fiber being detected and converted into one bit of information. The user's actions in marking the page may be guided by pictures and

words printed on the page, which may be made of paper. As an output device, selected optical fibers are driven with a light source which results in a display of information by light emanating from the perforations at the ends of the driven fibers. In a further embodiment, a light path is established by a fiber embedded in the page, in which the fiber is separated along its length at a point under a perforation, with occluding material deposited through the perforation for blocking transmission of light through the fiber. In another embodiment a matrix of fibers is embedded in a page, with connections of a row and a column at a crossover point being provided by a coupling fiber spliced therebetween, the coupling fiber being separated under a perforation in the paper through which occlusive material may be deposited to selectively block the optical coupling between the row and column. In a still further embodiment, the embedded fiber optic page may be used with either light-detecting or light-emitting pens.

Figures 7A, 7B, and 7C are diagrammatic illustrations of the utilization of the subject invention as a catalog sheet, as a game card, and a page in a book respectively. Referring to figure 7A, a catalog sheet 92 may be provided with a series of entry ports 94 adjacent written material generally indicated at 96. Moreover, a part number, price-quantity matrix 98 may be provided at the bottom of a catalog sheet, with entry ports as illustrated. Note that the user is relieved of error-prone detail such as recording the part number or price, since that information can be retrieved from knowledge of which apertures have been marked. Thus, the marking of the catalog sheet by a pencil 100 provides all of the necessary information, such that when the catalog is connected by a

fiber optic cable 102 to a decoding unit 104, the information encoded in the catalog sheet may be read out and displayed at 106 or provided to a modem 108 for direct transmission to a manufacturer.

With regarding to figure 7B, the subject input/output device may be in the nature of a game in which a game card 110 is provided with scratch-off indicia 112. The card is provided with appropriate entry ports for the optical fibers underneath the indicia. Only selected cards will have optical ends at the required scratch-off points such that only when these cards have these entry ports exposed to ambient light will it indicate that the user of the card has won. The card may be provided with a display area 114 which provides the player with a visual representation of the fact that the player has won when selected entry/exit ports are appropriately driven. Of course many types of games may be played in this manner with a connect-the-dots game being shown at 116. As in the case of the catalog sheet, the game card may be coupled via a fiber optic link 118 to any type of processing system either in the vicinity of the card or at a remote location.

With regarding to figure 7C, a textbook 120 may be provided not only with entry ports generally at 122, but also with a display such as illustrated at 124, with the book being coupled at its binding via a connector generally indicated at 126 to a local processing unit 128 by a fiber optic cable 130. Processing unit 128 may include light sources and detectors as well as decoding and encoding circuitry. This unit may be augmented by any type of auxiliary processing unit 132, which may include cassettes, microprocessors, a modem for telephone linkage to a remote computer, and the like.

The fiber optic page in book format allows the inexpensive medium of print to be combined with the advantages of computer-driven feedback to the user. In the process, the user is permitted to exercise a broad range of computer-readable, graphic actions, instead of being restricted to button-poking or knob-turning.

As can be seen, Mondshein discloses a printed catalog comprising machine recognizable feature that can be read, decoded, and displayed to a user via display 106 or to a remote devices via modem 108, and telephone lines.

Claim 169-261, 263-264, 266 and 267, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mondshein (Mondshein – 4,418,278; cited above) in view of the general teachings of the prior art of record .

Regarding claims 170-261, 263-264, 266 and 267, see the discussions above. The claims differ in calling for the use of an alternative form of a code such as a watermark, an invisible barcode, a magnetic code, a printer character, a invisible icon, etc. The claim also recites the use of various different type of networks, the use of a menu, listings, the method of payments and shipments. It would have been obvious to incorporate all these limitations in the system as taught by Mondshein. Though Mondshein discloses the use of a data link, he is silent whether it is used to carry data, video, image, shopping data, online shopping data, etc. However, the use of specific types of data would merely design considerations which would be well within the skill levels and expectations of an ordinary skilled artisan in the art. Further, the general teachings of the prior art include the use of a watermark, a magnetic code, a printed

character, an icon, etc., as a data input source. Without any specific and unexpected result, replacing one source of input with another known source of input would have been design consideration; and would have not been considered novel. For similar reasons, it would have been obvious to replace one type of network with another since the use of various different networks are known to an ordinary skilled artisan in the art. Choosing one type of network over another would merely depend on the type of applications, the services being offered. Finally, it would have been obvious to include the claimed steps of providing payment, shipping, and returning information in the combined systems. The methods of providing payment/shipping/returning information are notorious known and old and have been made commercially available. Various references in the cited prior art of record are herein discussed as evidence showing the conventionality of some of the claimed limitations.

Veeneman discloses a multi-merchant gift registry system. The system includes a bar code scanner 40 could be located in a registrant's home such that the registrant could register for items from multiple merchants via a catalogue that includes bar codes for the items. The registrant would communicate to the kiosk via remote communication, such as a modem or the InterNet. The term catalog should be understood to be not limited to a physical paper catalog, but also encompasses things such as CD-ROMs, and other data storage devices. In this embodiment, it would be required that there be a unique bar code for each catalog to identify the supplier of the particular item. This identifying code could be on the front cover, the back cover, or somewhere within the catalog.

Montanari et al. disclose a method for tracking the production history of food product. FIG. 1 shows a tag that is encoded with a Tracking Number. According to Montanari, the tag is used to convey 1) an Animal Tracking Number (A-TN) which is the tracking number applied to a live animal; 2) an Offal Tracking Number (O-TN) which is attached to offal products; 3) a Production Tracking Number (P-TN) that is attached to a quarter of meat and that identifies fabricated primals and sub-primals derived from the animal of origin; and 4) a Retail Tracking Number (R-TN) that is presented on a primal or sub-primal cut for retail identification. As ownership and possession of an animal is transferred, the Animal Tracking Number (A-TN) is recorded on a tag, preferably in an electronic or computer readable form, such as a bar-code or magnetic strip, and vital information, such as prior owners, genetic history, weight, feeding history, microbacterial profiles, diseases, medications, etc., may be added to the database record via such tag at various times in the growth of the animal, as well as in the fabrication process.

Sangster discloses a system wherein each student station comprises a microcomputer into which the student inputs response to the situations presented on the television monitor by the videodisc player. Selected video signals from the videodisc on the videodisc player are digitized and stored in a computer memory. These stored video signals represent simulated outcomes corresp. to the responses of the students. According to Sangster, the different responses of the students cause either the video signals stored in the computer memory to be converted into analog



format and applied to the approp. television monitors, or causes the videodisc player to access an approp. portion of the videodisc. A multiport transmitter controllable by signals from the microcomputers results in the approp. video signals being applied to the approp. television monitors. Fibre optic video links between the videodisc player and the television monitors permit interference-free transmission.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 168, 262 and 265 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,932,863 (herein referred to as the '863 patent).

Similar to claims 168, 262, and 265 of the instant application, claim 1 of the '863 patent recites:

1. A system for displaying programming to a user, the system comprising:

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a printed matter having at least one machine recognizable feature;

a feature recognition unit having associated therewith a means for recognizing said feature and a transmitter for transmitting a coded signal in response to the recognition of said feature;

an intelligent controller having associated therewith a receiver for receiving said coded signal and a means for accessing programming material; and

a display unit for presenting said programming material;

wherein said recognition unit, in response to the recognition of said feature, causes said intelligent controller to access said programming material and said display unit to execute or display said programming material, and

wherein said display unit comprises a personal computer.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they all recited the same limitations; and thus would have been obvious in view of each other. As can be seen, the patent protections have been granted in an earlier filed patent application.

### ***Response to Arguments***

Applicant's arguments with respect to claims 168-267 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (703) 305-3500. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to be 'Thien Minh Le', written in a cursive style.

**Le, Thien Minh**  
**Primary Examiner**  
**Art Unit 2876**  
**November 27, 2002**